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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065
27074	7590	08/29/2005	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,835

Applicant(s)

TAYLOR ET AL

Examiner

Laurie Ries

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: request for continued examination, filed 4 August 2005, to the original application filed 19 October 2001.
2. Claims 1-7 and 9-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky.
3. Claims 8 and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky and Evans (U.S. Patent 6,363,179 B1).
4. Claims 1-19 are pending. Claims 1, 9, and 19 are independent claims.

Claim Rejections - 35 USC § 103

5. Claims 1-7, 9-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries").

As per claims 1-2 and 9-11, Price discloses a system and method of processing at least two documents stored in at least one database, including a source document and a target document (See Price, Page 33, Column 2, paragraphs 4-5, and Page 34,

Column 1, paragraph 1) including a search device for searching the target document to identify whether any words of interest are present in the target document (See Price, Page 34, Column 1, paragraph 3), and an annotation device for annotating the words located in the target document (See Price, Page 34, Figure 5). Price also discloses that the documents are pre-selected by a user of the system. Note that "pre-select" is defined as "to select beforehand, usually according to a specific criterion" (See The American Heritage Dictionary of the English Language, Fourth Edition, as cited by www.dictionary.com). Price discloses that all documents are stored on local disk or, in another implementation, on a remote database (See Price, Page 36, Column 1, "Link Construction", lines 1-6). In either case, the criterion for pre-selection of the documents in the collection of Price is the set of documents existing in the collection of documents loaded into the local disk or remote database. As such, this is a finite set of documents pre-selected by a user of the system, i.e., the pre-selection of the document collection that he or she is using the system to access and manipulate (See Price, Page 36, Column 1, paragraphs 2 and 5). Price does not disclose expressly detecting one or more annotated regions in a source document, and inputting and storing a number of words of interest, each of the words stored as a result of being annotated in the source document. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from

the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claims 1-2 and 9-11.

As per claims 3 and 12, Price and Golovchinsky disclose the limitations of claims 2 and 10 as described above. Price also discloses including a capture device for optically capturing a digital image of a physical source document (See Price, Page 35, Column 2, paragraph 6).

As per claims 4 and 13, Price and Golovchinsky disclose the limitations of claims 3 and 11 as described above. Price also discloses detecting annotations in a captured image of the source document (See Price, Page 34, Column 1, paragraphs 2-3).

As per claims 5 and 14, Price and Golovchinsky disclose the limitations of claims 4 and 13 as described above. Price also discloses detecting a type of annotation (See Price, Page 34, Column 1, paragraph 2).

As per claims 6 and 15, Price and Golovchinsky disclose the limitations of claims 5 and 14 as described above. Price also discloses that the type of annotation

detected includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring (See Price, Page 34, Column 1, paragraph 2).

As per claims 7 and 16, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price also discloses optically capturing a digital image of a physical target document to be annotated (See Price, Page 35, Column 2, paragraph 6).

As per claim 19, Price discloses a device implemented method of processing at least two documents including inputting a source document (See Price, Page 35, Column 2, paragraph 6, and Page 36, Column 1, paragraphs 1-2), inputting a target document, the target document pre-selected by a user of the device (See Price, Page 36, Column 1, paragraph 5). Price also discloses that the documents are pre-selected by a user of the system. Note that "pre-select" is defined as "to select beforehand, usually according to a specific criterion" (See The American Heritage Dictionary of the English Language, Fourth Edition, as cited by www.dictionary.com). Price discloses that all documents are stored on local disk or, in another implementation, on a remote database (See Price, Page 36, Column 1, "Link Construction", lines 1-6). In either case, the criterion for pre-selection of the documents in the collection of Price is the set of documents existing in the collection of documents loaded into the local disk or remote database. As such, this is a finite set of documents pre-selected by a user of the system, i.e., the pre-selection of the document collection that he or she is using the system to access and manipulate (See Price, Page 36, Column 1, paragraphs 2 and 5). Price does not disclose expressly annotating the source document to identify a number

of words of interest and storing the words of interest. Golovchinsky discloses retaining the selection of an instance of a word on a page where the word is stored as a result of an annotation, such as being highlighted by a user (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claim 19.

6. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price ("Linking By Inking: Trailblazing in a Paper-Like Hypertext") in view of Golovchinsky ("From Reading to Retrieval: Freeform Ink Annotations as Queries"), as applied to claims 1 and 9 above, and further in view of Evans (U.S. Patent 6,363,179 B1).

As per claims 8 and 17, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price and Golovchinsky do not disclose expressly that the annotating includes annotating one or more words in the target document using the same type of annotation as used in a source document from which the stored words are derived. Evans discloses highlighting the text in a second document that corresponds to the highlighted text in a first document. (See Evans, Column 2, lines 1-14). Price, Golovchinsky and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the highlighting annotations of Evans with the source and target documents of Price and Golovchinsky. The motivation for doing so would have been to display in a visually distinct manner a region of the second document image that corresponds to the matching word in the first document so that the user may more easily identify a matched search term. (See Evans, Column 2, lines 15-18). Therefore, it would have been obvious to combine Evans with Price and Golovchinsky for the benefit of easily identifying matching terms in a first and second document to obtain the invention as specified in claims 8 and 17.

As per claim 18, Price and Golovchinsky disclose the limitations of claim 9 as described above. Price also discloses that the method is implemented by a set of program instructions stored in a storage medium and executable on a data processing device (See Price, Page 30, "Abstract").

Response to Arguments

7. Applicant's arguments filed 4 August 2005 have been fully considered but they are not persuasive. Applicant argues on Page 6 of the Instant Amendment that the prior art fails to disclose that the source and target documents are pre-selected from the database by a user of the system. The Office respectfully disagrees. Price discloses that the features described in the reference, "Linking By Inking: Trailblazing in a Paper-Like Hypertext", have been implemented in a system called XLibris (See Price, Page 35, Column 2, "Implementation", paragraph 1, lines 1-4). Price also discloses that while the current implementation stores all indexed documents (emphasis added) on local disk, queries could be run on remote databases as well, thus allowing for the user of XLibris as an interface to a digital library or database (See Price, Page 36, Column 1, "Link Construction", lines 1-6). Since Price states that all documents are indexed, it is reasonable to conclude that the pre-selected source and target documents are pre-selected based on their inclusion in the document index (i.e. documents **not** included in the index of documents would not be pre-selected). Price has shown that only documents contained within the document index, or remote database in another implementation, would be included in the finite set of documents pre-selected by a user of the system.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mohit (U.S. Publication 2005/0060162 A1) discloses systems and methods for automatic identification and hyperlinking of words or other data items and for information retrieval using hyperlinked words or data items.
- Pringle (U.S. Patent 6,470,306 B1) discloses automated translation of annotated text based on the determination of locations for inserting annotation tokens and linked ending, end-of-sentence or language tokens.
- Jiang discloses spatial and temporal content-based access to hypervideo databases.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/24/2005